

REMARKS

The Office Action dated December 1, 2005, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. **THE ENABLEMENT REJECTION OF CLAIMS 8-10**

On page 2 of the Office Action, claims 8-10 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Office Action alleges that the main body and the contact surface are circular or cylindrical in shape and do not form a plane. This rejection is hereby respectfully traversed.

Claim 8 recites "said contact surface lying in the same plane as and forming an extension of a portion of said outer surface of said main body portion." Applicant respectfully submits that two circular or cylindrical shapes (e.g., two coins) may indeed "lay" in the same plane. For example, a dime lying on a nickel would be coplanar with the nickel. Similarly, Applicant respectfully submits that, as recited in claim 8, the contact surface may in fact "lay" in the same plane as and form an extension of a portion of said outer surface of said main body portion. Thus, Applicant respectfully submits that claim 8 is described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Claims 9 and 10 depend from claim 8 and are also properly described in the specification.

In view of the foregoing, it is respectfully requested that the aforementioned enablement rejection of claims 8-10 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 1-5 AND 7-11¹

On page 2 of the Office Action, claims 1-4 and 7-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caspar (U.S. Patent No. 5,339,915) in view of Oxland (U.S. Patent No. 5,676,666). On page 3 of the Office Action, claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Caspar in view of Oxland, and further in view of Paul (U.S. Publication No. 2002/0065517). These rejections are hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner alleges that Casper discloses a bone fixation system in Figure 2 comprising a plate 29 having openings, the openings having a length and width. The Examiner further alleges that Casper discloses a drill guide comprising first and second guide members each having a passage, offset portions and contact surface pointed to by lead line 8. The Examiner further alleges that a plane may be formed between a portion of the main body and including a portion of the contact surface.

¹ Applicant respectfully submits that independent claim 6 has not been addressed in the Office Action. Applicant respectfully requests that the next Office Action expressly address the merits of dependent claim 6.

Applicant respectfully submits, however, that Casper does not teach or suggest “a plate having a top and bottom surface and *a central axis extending longitudinally between a first end and a second end*, said plate having a plurality of openings between said top and bottom surfaces, wherein *a pair of said openings are first and second slots positioned on opposing sides of said central axis*, said first and second slots each having a width transverse to said central axis and a length extending between first and second ends of said slot in the direction of said central axis, said length being greater than said width,” as expressly recited in independent claim 1. In particular, Applicant respectfully submits that Casper does not teach or suggest: (1) a central axis extending longitudinally between a first end and a second end, OR (2) a plurality of openings..., wherein a pair of said openings are first and second slots positioned on opposing sides of said central axis.

Rather, Applicant respectfully submits that Casper merely discloses a bone plate 29 that includes a series of holes, but does not specifically disclose that such holes are “positioned on opposing sides of a central axis,” as expressly required by independent claim 1. In fact, Applicant respectfully submits that Casper does not teach or suggest any feature that even remotely comprises “a central axis” extending longitudinally between a first end and a second end of the bone plate 29. Moreover Applicant respectfully submits that Casper does not disclose a pair of openings that are first and second slots positioned on opposing sides of said central axis. Applicant respectfully submits that Oxland does not make up for Casper’s deficiency in this regard. Accordingly, Applicant respectfully submits that the alleged combination of Casper and Oxland does not disclose each and every limitation of independent claim 1.

Further, Applicant respectfully submits that Paul is not prior art to the pending claims. In particular, Applicant respectfully submits that the subject matter of claim 5 is disclosed in Serial

No. 09/417,402 (now U.S. Patent No. 6,533,786), the parent of the above application (the "Parent Application"). The Parent Application has a filing date of October 13, 1999, which is earlier than Paul's filing date of November 28, 2000. For example, Applicant respectfully submits that the subject matter of claim 5 is disclosed in Col. 7, lines 21-23 of the Parent Application ("A groove 39 extends along axis L of plate 31 and intersects with each of recesses 45, 46, 47 along the length of groove 39.") Therefore, for at least this reason, Applicant respectfully submits that claim 5 is allowable over the cited references.

Claims 2-11 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-11 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 5 wherein said plate defines a groove in said top surface extending longitudinally along said central axis of said plate, said groove overlapping each of said first and second slots. Applicant respectfully that none of the cited references – alone or in combination – teach or suggest the bone fixation system of claim 1 wherein said plate defines a groove in said top surface extending longitudinally along said central axis of said plate, said groove overlapping each of said first and second slots.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-5 and 7-11 be withdrawn.

III CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed

telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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